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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,811	09/15/2003	Guy Nathan	2302-16	7387
23117 7590 03/04/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER MURDOUGH, JOSHUA A				
ART UNIT 3621		PAPER NUMBER		
MAIL DATE 03/04/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,811

Applicant(s)

NATHAN ET AL.

Examiner

JOSHUA MURDOUGH

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 14 November 2008 has been entered.

Acknowledgements

2. This action is responsive to Applicants' RCE received 9 December 2008.
3. Claims 43-79 are pending and have been examined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 43-45, 47-49, 53-55, 57-63, and 65-67 are rejected under 35 U.S.C. §102(b) as being anticipated by Knowles (US 5,481,509).
6. As to claim 43, Knowles shows:

- a. A jukebox device 5, comprising:
 - b. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media (Figure 4A, step 120) available for playback via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);
 - c. a second storage location (Figure 2, middle element 52) storing a second plurality of instances of media (Figure 4A, step 120) available for playback via the jukebox device for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being higher than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower); and
 - d. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the selected instance of media on the jukebox device ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5),
 - e. wherein the first storage location is different from the second storage location (top/middle 52 in Figure 2).
- 7. As to claim 44, Knowles further shows:
 - f. the first and second storage locations respectively comprise first and second disk drive devices(Id.).

8. As to claim 45, Knowles further shows:
 - g. the first and second storage locations respectively are located on first and second areas of a single disk drive device (Column 1, lines 60-62 shows that there may be only one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).
9. As to claim 47, Knowles further shows:
 - h. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).
10. As to claim 48, Knowles further shows:
 - i. the first and second storage locations are updatable independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).
11. As to claim 49, Knowles further shows:
 - j. a selected instance of media from said second plurality of instances of media becomes at least temporarily available on the first storage location (wherein the first

location contains “New Video Releases” **208** and the second is the whole collection of “Video[s]” **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

12. As to claim 53, Knowles shows:

- k. A digital audiovisual distribution network, comprising:
 - l. a plurality of jukebox devices respectively located at a plurality of locations; and
 - m. a central server **100** operably connected to a repository **112** of instances of media distributable to the jukebox devices via the network (Column 5, lines 51-61);
 - n. wherein each said jukebox device (Figure 2) comprises:
 - o. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);
 - p. a second storage location (Figure 2, middle element 52) storing a second plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being higher than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower); and
 - q. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the

selected instance of media on the jukebox device ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5),

r. wherein the first storage location is different from the second storage location.

13. As to claim 54, Knowles further shows:

s. the first and second storage locations respectively comprise first and second disk drive devices (top/middle 52 in Figure 2).

14. As to claim 55, Knowles further shows:

t. the first and second storage locations respectively are located on first and second areas of a single disk drive device (Column 1, lines 60-62 shows that there may be only one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).

15. As to claim 57, Knowles further shows:

u. the second plurality of instances of media substantially mirrors the repository of instances of media operably connected to the central server (Column 5, lines 21-33).

16. As to claim 58, Knowles further shows:

v. the first and second storage locations are updatable via the network independent of one another (as there is no disclosure of anything binding the drives together and they

are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

17. As to claim 59, Knowles further shows:

w. an instance of media from said second plurality of instances of media selected for playback is at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

18. As to claim 60, Knowles further shows:

x. an instance of media stored in the repository of the central server, subsequent to user request, is downloadable to a storage location of one said jukebox device (Column 5, lines 21-33) for a third fee or number of credits (as evidenced by Figure 4A, step 136), the third fee or number of credits being higher than the second fee or number of credits (multiple prices are disclosed, if there are 3 prices, one is going to be the highest, one will be the middle, and one will be the lowest).

19. As to claim 61, Knowles shows:

y. A method of operating a jukebox device, comprising:

- z. providing a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);
 - aa. providing a second storage location (Figure 2, middle element 52) storing a second plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being higher than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower); and
 - bb. receiving, via a user interface provided to the jukebox device (Figure 5, element 200), user input corresponding to a selection of an instance of media available for playback from the first and second pluralities of instances of media for playback on the jukebox device ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5),
 - cc. wherein the first storage location is different from the second storage location (top/middle 52 in Figure 2).
20. As to claim 62, Knowles further shows:
- dd. the first and second storage locations respectively comprise first and second disk drive devices (1d.).
21. As to claim 63, Knowles further shows:

cc. the first and second storage locations respectively are located on first and second areas of a single disk drive device Column 1, lines 60-62 shows that there may be only one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).

22. As to claim 65, Knowles further shows:

ff. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

23. As to claim 66, Knowles further shows:

gg. updating the first and second storage locations independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

24. As to claim 67, Knowles further shows:

hh. making available on the first storage location, at least temporarily, a selected instance of media from said second plurality of instances of media (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of

“Video[s]” 202; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 71-79 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of Shneidman (US 2006/0038794).

27. As to claims 71, 74, 76, and 77, Knowles shows:

- ii. A jukebox device **5** configured to playback an instance of media selected by a user (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5), comprising:
 - jj. at least one storage location **52** configured to store instances of media available for playback via the jukebox device (Figure 4A, step 120), the instances of media being divided into first and second subsets of media, the first and second subsets of media being different from one another (Figure 4A, steps 120 and 124); and
 - kk. a user interface provided to the jukebox device configured to enable a user to select an instance of media from the instances of media in order to initiate playback of the

selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5),

ll. the user interface comprising a first display configured to enable a user to select the instance of media for playback from the first subset of media **18** for a first fee or number of credits (as evidenced by Figure 4A, step 136), and

mm. the display configured to enable a user to select the instance of media for playback from at least the second subset of media (Figure 4A, step 120) for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being greater than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower), and

nn. second display screen configured to enable a user to select the instance of media for playback (Figure 5, element 220).

28. Knowles does not expressly show that the list of media is searchable.

29. Shneidlman shows “multi-searchable jukebox type applications” (Paragraph [0063]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to include a search, as taught by Shneidlman, in order to allow users to access the system and provide them with an easier method of finding and accessing the media.

30. As to claim 72, Knowles further shows:

oo. the first display screen includes a list of artists for each said instance of media in the first subset of media (“Touch here to sort by title or artist” Figure 5).

31. Knowles in view of Shneidman teaches a list of artists being displayed on a jukebox. However, it does not expressly teach the specific data recited in claim 73 (the album art). Nevertheless, the difference(s) are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

32. As to claim 75, Knowles further shows
pp. the second display is configured to display search results **220** after at least some instances of media not included in the first subset of media are searched for instances of media matching the search criteria.

33. As to claim 78, Knowles further shows:
qq. the search results are selectable by the user in order to initiate playback of the selected search result by the jukebox device for the second fee or number of credits (as evidenced by Figure 4A, step 136).

34. As to claim 79, Knowles further shows:

rr. the first and second displays are each configured to allow a user to supply an additional fee or number of credits in order to make the selected instance of media play immediately after a currently playing instance of media (through element 20).

35. Claims 46, 56, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles in view of Waingrow (Unix Hints & Hacks).

36. Knowles shows as discussed above in regards to claims 43, 53, and 61; but does not expressly show:

ss. the first and second storage locations respectively comprise first and second partitions of a single disk drive device of the jukebox device.

37. Waingrow teaches the creation of partitions on a hard drive to separate data in order to prevent complete failure of the hard drive (Pages 14-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to create a formal separation on the hard drive, in the form of partitions in order to isolate each type of file. This way, if one File Allocation Table (FAT) became corrupt, the data on the entire hard drive was not lost but only one partition.

38. Claims 50, 51, 68, and 69 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of Bowman-Amuah (US 6,289,382).

39. Knowles shows as described above in regards to claims 43 and 61 but does not show the encryption of the media as claimed in these claims.

40. However, Bowman-Amuah shows the encryption of the media in a jukebox system (Column 90, lines 25-37) by use of different mechanisms (Columns 81-82, lines 55-19). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to encrypt the media as shown by Bowman-Amuah in order to prevent unwanted access to the media.

41. Claims 52 and 70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles and Bowman-Amuah as applied to claims 51 and 69 above, and further in view of Dunning (US 7,024,485).

42. The Knowles/Bowman-Amuah combination discloses as discussed above, but does not expressly disclose:

tt. each instance of media in the second plurality of instances of media is missing a predetermined number of bytes, said missing bytes being stored in separate respective locations and being at least temporarily insertable into the respective instances of media to enable playback by the jukebox device.

43. However, Dunning shows a jukebox (Figure 2, 103) that splits the content file (Figure 3A, 2714) and only keeps a portion of it (Figure 3A, 2718). When the complete file is requested, the jukebox receives the other portion of the file (Figure 3C, 2734) and combines it with the part stored on the jukebox (Figure 3C, 2738). It would have been obvious to one of ordinary skill in

the art at the time of the invention to have further modified the teachings of Knowles to include the divided storage of Dunning for reasons including, preventing a complete copy of the file from residing on the jukebox where it could be copied (Dunning, Column 6, lines 24-25).

Response to Arguments

44. Applicant's arguments filed 14 November 2008 have been fully considered but they are not persuasive.

45. Applicants argue:

46. "Claim 43 recites, inter alia, "a first storage location storing a first plurality of instances of media available for playback via the jukebox device for a first fee or number of credits; [and] a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits." Claims 53 and 61 require similar features. Knowles does not disclose these features of claim 43, or the similar features of claims 53 and 61" (Remarks, Page 13, Paragraph 4).

47. Examiner's response:

48. First, Knowles teaches multiple storage locations. Each of the three (3) hard disks 52 in Figure 2 constitutes a different storage location. Also, CD 104, VCR 106, and laser disk 108 are storage locations.

49. Each of the above mentioned storage devices store one or more pieces of media "available for playback" (C 3, LL 33-43 & C 5, LL 34-40).

50. Each instance of media has an associated price (C 6, LL 50-52). This price is compared to the coins or other payment deposited in step 154.

51. Claims 43 and 53 are understood to be apparatus claims. As such, they are subject to interpretation as outlined by MPEP § 2114, wherein it says, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" and "[A]pparatus claims cover what a device is, not what a device does." While the Examiner has cited references for the functional limitations "available for playback via the jukebox device for a first fee or number of credits" and "available for playback via the jukebox device for a second fee or number of credits being higher than the first fee or number of credits" that do not require an alteration of the structure for purposes of compact prosecution, it is his principal position that these elements do not need to be shown in order to show anticipation.

52. Additionally, the words "available" and "for" in these instances are considered to precede the intended use of these systems and method. Being available does not positively recite the use in this manner. Therefore, these limitations are given less weight according to MPEP § 2106.

53. Applicants argue:

54. "Although Knowles discloses charging a fee for plays, it is completely silent regarding charging a first fee or number of credits for playing back instances of media from the first hard

drive, and charging a second fee or number of credits for playing back instances of media from the second hard drive” (Remarks, Page 13, Paragraph 5).

55. Examiner's response:

56. The Examiner respectfully disagrees. Knowles discloses “the program displays the titles available along with the price to play each title for the format” (C 6, LL 50-52). Media on a hard disk, CD, VCR, and laser disk would be in different formats. Moreover, Knowles discloses, “[t]he jukebox system includes a first computer system having one or more hard disc drives coupled thereto, each of which has digital audio/video data stored thereon” (C 1, LL 58-63). Therefore Knowles reasonably teaches one of ordinary skill that different prices can be charged for different formats and different formats can be stored in different locations.

57. Applicants argue:

58. “Claim 71 recites, inter alia, a “user interface comprising a first display screen configured to enable a user to select the instance of media for playback from the first subset of media for a first fee or number of credits, and a second display screen configured to enable a user to select the instance of media for playback from at least the second subset of media for a second fee or number of credits.” The alleged Knowles/Shneidman two-way combination does not disclose these features of claim 71” (Remarks, Page 14, Paragraph 4).

59. Examiner's response:

60. Again, these are functional and intended use limitations in an apparatus claim. The claim recites "configured to enable...number of credits." The phrase "configured to enable" fails to make the limitation a positive recitation. Additionally, the user is "to" select. The user selecting media for playback from a subset is functional and does not change the underlying structure.

61. Additionally, as noted above, Knowles allows for the selection of different types of media with different prices for playing the different formats. Knowles also shows an interface (Figure 5) where users can select the different formats (202, 204, 206) and selections from the selected format ("touch the title of your choice," 220).

62. Applicants challenge the Examiner's taking of Official Notice in the previous action. They argue that "the corruption of the file allocation table (FAT) would not be confined to a particular partition, and the failure would not be prevented." This is not correct. Each logical drive (partition or volume) has its own FAT (Kozierok, Paragraph 2). The FAT only contains data about the files on that logical drive. Thus, if the FAT is corrupted, only that logical drive is lost.

63. Moreover, Waingrow teaches storing files on different partitions when different drives are not available to protect from losing both files from the same data issue (Pages 14-15).

64. However, the Examiner has withdrawn the Official Notice and cited Waingrow in its place.

Conclusion

65. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.
66. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
67. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621